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MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/990,670		HICKS, THOMAS	
	Examiner		Art Unit	
	Elena Tsoy		1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5,22-26,36 and 38-61 is/are pending in the application.
- 4a) Of the above claim(s) 38,39,42-50,52 and 53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5,22-26,36,40,41,51 and 54-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Amendment filed on 10/19/2005 has been entered. Claims 1-3, 6-21, 27-35, and 37 have been cancelled. New claims 51-61 have been added. Claims 4-5, 22-26, 36, 38-61 are pending in the application. Claims 38-39, 42-50, and 52-53 are withdrawn from consideration as directed to a non-elected invention.

Election/Restrictions

1. Newly submitted claims 52-53 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the inventions of claims 52-53 are distinct because the product as claimed can be made by another and materially different process such as a process comprising half-tone printing (MPEP § 806.05(f)).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 52-53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Declaration under 37 CFR 1.132

2. The Declaration under 37 CFR 1.132 filed February 10, 2005 is insufficient to overcome the rejection of claims based upon Charley et al. The examiner maintains the rejection over Charley et al because at column 2, lines 47-60, Charley et al teach printing without the use of a layer of opaque white. Note that a mirror-image printing is just a preferred embodiment in Charley et al. It is held that preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See MPEP 2123. Therefore, *non-preferred*

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method of Charley et al **without** the use of a layer of opaque white is as relevant as a preferred method with the use of a layer of opaque white.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 40, 41, and 58-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 recites the limitation "The method" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 60, line 2, a phrase "flexible plastic film material is non-homogeneous in color" renders the claim indefinite because it is not clear whether plastic film itself is *non-homogeneous* in color or a printed image is not *homogeneous* in color. For examining purposes the phrase was interpreted according to the specification (See page 8) as printed image being *non-homogeneous* in color.

Claim Objections

5. Claims 41, and 57-61 are objected to because of the following informalities:

Claims 41, 58-61, line 1, "The window covering of claim 40" should be changed to "The method of claim 40".

Claim 57, line 1, "A process of claim 4" should be changed to "The process of claim 4".

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6. Claim 60 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation “flexible plastic film material is non-homogeneous in color” fails to further limit claim 40 because the film has printed image of a stained glass, i.e. *non-homogeneous* in color.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Rejection of claims 40-41 under 35 U.S.C. 102(b) as being anticipated by Oberwager (US 3,815,263) has been withdrawn due to amendment.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 40, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager (US 3,815,263) in view of Holt (US 4,127,689).

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Oberwager disclose a process for producing window covering by applying a simulated stained glass design to a self-adhering vinyl sheet capable of removably (See column 2, lines 39-45) covering the entire window (See column 2, lines 6-9). The design can be created by printing on front sheet lead lines to form panels and shading pattern, and further applying colored cut out sections of plastic sheets to the panels to create the desired colored pattern (See column 2, lines 9-15).

Oberwager fails to teach that a simulated stained glass design can be made by using a translucent vinyl sheet, and applying onto the panels formed by lead lines *translucent* color inks having UV-inhibitor to create the desired colored pattern.

Holt teaches that a simulated stained glass can be made from either transparent or *translucent* plastic sheet (See column 1, lines 60-61), and colored pattern can be produced in panels formed by lead lines (See column 2, lines 13-29) by applying onto the plastic sheet *transparent* or *translucent* color inks having UV-inhibitor (See column 2, lines 29-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made a design of simulated stained glass in Oberwager by using *translucent* plastic sheet and applying *translucent* color inks having UV-inhibitor to the translucent vinyl sheet instead of applying colored cut out sections of plastic sheets to a transparent vinyl sheet since Holt teaches that a simulated stained glass can be made from either transparent or *translucent* plastic sheet, and colored pattern can be produced in panels formed by lead lines by applying onto the plastic sheet color inks having UV-inhibitor.

11. Claims 41 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Boden (US 3562941).

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Oberwager in view of Holt are applied here for the same reasons as above. Oberwager in view of Holt fails to teach that the translucent vinyl sheet is made by applying a *translucent* matte finish to a clear film material.

Boden teaches that instead of translucent plastic, a transparent plastic having a translucent coating (claimed matte finish) on its rear side can be used (See column 5, lines 73-75) for making daylight visual displays (See column 6, lines 43-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a clear film material having a *translucent* matte coating on its rear side instead of the translucent vinyl sheet of Oberwager in view of Holt since Boden teaches that instead of translucent plastic, a transparent plastic having a translucent coating on its rear side can be used for making daylight visual displays.

Obviously, the same daylight visual effect would be achieved in Oberwager in view of Holt in view of Boden if clear film material 14 were having a *translucent* matte coating on its front side.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a clear film material having a *translucent* coating on its front side instead of the translucent cling vinyl sheet of Oberwager in view of Holt in view of Boden since obviously, the same daylight visual effect would be achieved if clear film material were having a *translucent* coating on its front side.

12. Claims 4, 22-23, 26, 36 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Boden, and further in view of Taylor et al (US 5,672,413).

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Oberwager in view of Holt in view of Boden are applied here for the same reasons as above. Oberwager in view of Holt in view of Boden fails to teach that the vinyl sheet has thickness in the range of 4-10 mils.

Taylor et al teach that polyvinyl chloride film about 50-150 microns thick (2-6 mils) commonly known as cling vinyl or static cling vinyl are flexible and can be used for carrying an image thereon to produce self-adhering stickers for automobile windows (self-adhering window covering), decals, etc. (See column 4, lines 27-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a translucent cling vinyl film 16 having thickness in the range of 2-6 mils in a film of Oberwager in view of Holt in view of Boden with the expectation of providing the desired self-adhering printed window covering since Taylor et al teach that cling vinyl or static cling vinyl having thickness of 2-6 mils can be used for carrying an image thereon to produce stickers for automobile windows (self-adhering window covering), decals, etc.

13. Claims 24, 54, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Boden, and further in view of Taylor et al, and further in view of Charley et al (US 6,030,002).

Oberwager in view of Holt, further in view of Boden and Taylor et al are applied here for the same reasons as above. Oberwager in view of Holt, further in view of Boden and Taylor et al fails to teach that a second translucent matte varnish is applied over a printed image (Claims 24, 56); the inks are printed using lithographic printing process (Claims 54, 56).

Charley et al teach that a colored design 20 can be produced by lithographic offset printing process (See column 1, lines 21-35) to a clear or translucent cling vinyl film 16 (See

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column 2, lines 34, 45-55) of a film material 14, then covering with a very thin layer of *translucent* varnish 36 (claimed second matte finish) (See column 2, lines 23-24, 55-58), thereby forming a *translucent* cling decal for covering window (See column 4, lines 8-9). Charley et al further teach that inks are of Werneke Series (See column 3, lines 13-22), and the varnish is UV-curable varnish (See column 3, lines 20-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used lithographic offset printing process for applying clear or translucent inks, and applied a second matte varnish in Oberwager in view of Holt, further in view of Boden and Taylor et al since Charley et al teach that a colored design 20 can be produced by lithographic offset printing process to a clear or translucent cling vinyl film then covering with a very thin layer of *translucent* varnish thereby forming a *translucent* cling decal for covering window.

14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Boden, and further in view of Taylor et al, and further in view of Chmielnik (US 5,617,790).

Oberwager in view of Holt, further in view of Boden and Taylor et al are applied here for the same reasons as above. Oberwager in view of Holt, further in view of Boden and Taylor et al fails to teach that colors are provided by cyan, magenta and yellow inks.

Chmielnik teaches that the individual colors may be provided by inks in the primary colors of cyan, magenta and yellow.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used primary colors of cyan, magenta and yellow in inks of Oberwager in view of Holt, further in view of Boden and Taylor et al with the expectation of providing the

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desired color images, since Chmielnik teaches that the individual colors may be provided by inks in the primary colors of cyan, magenta and yellow.

15. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, further in view of Chmielnik.

Oberwager in view of Holt are applied here for the same reasons as above. Oberwager in view of Holt fails to teach that colors are provided by cyan, magenta and yellow inks.

Chmielnik teaches that the individual colors may be provided by inks in the primary colors of cyan, magenta and yellow.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used primary colors of cyan, magenta and yellow in inks of Oberwager in view of Holt with the expectation of providing the desired color images, since Chmielnik teaches that the individual colors may be provided by inks in the primary colors of cyan, magenta and yellow.

16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberwager in view of Holt, in view of Boden, in view of Taylor et al, in view of Charley et al, and further in view of Rega et al (US 6,054,208) and GB 2324381.

Oberwager in view of Holt in view of Boden in view of Taylor et al in view of Charley et al are applied here for the same reasons as above. Oberwager in view of Holt in view of Boden in view of Taylor et al in view of Charley et al fails to teach that UV-curable varnish contains UV absorber and a hardening agent.

Rega et al teach that UV absorber added to UV curable systems including UV inks provides weathering protection (See column 14, lines 47-63).

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GB 2324381 teaches that the use of a crosslinking (hardening) agent in a coating composition improves scratch resistance by promoting crosslinking upon exposure to UV light (See page 6, lines 15-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added UV absorber and a hardening agent to UV-curable varnish in a colored cling decal of Oberwager in view of Holt in view of Boden in view of Taylor et al in view of Charley et al with the expectation of providing the colored design with desired UV absorbing properties for weathering protection, as taught by Rega et al, and the desired improved scratch resistance, as taught by GB 2324381.

17. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al in view of Boden.

Charley et al disclose a process of producing window decals comprising applying (transparent) inks (See column 3, lines 17-20) through lithographic offset printing process (See column 1, lines 21-35) to a clear or translucent cling vinyl film 16 (See column 2, lines 34, 45-55) of a film material 14 to make a printed colored design 20, then covering with a very thin layer of *translucent* varnish 36 (claimed second matte finish) (See column 2, lines 23-24, 55-58), thereby forming a *translucent* cling decal for covering window (See column 4, lines 8-9). The cling decal self adheres to window glass (non-porous) surface via static cling (through cohesion and atmospheric pressure) by peeling back the carrier 18 from the film 16 and pressing the film 16 to the glass surface (See column 4, lines 6-15). Charley et al further teach that inks are of Werneke Series (See column 3, lines 13-22), and the varnish is UV-curable varnish (See column 3, lines 20-27).

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Charley et al fails to teach that the translucent cling vinyl film 16 is made by applying a *translucent* matte finish to a clear film material 14.

Boden teaches that instead of translucent plastic, a transparent plastic having a translucent coating (claimed matte finish) on its rear side can be used (See column 5, lines 73-75) for making daylight visual displays (See column 6, lines 43-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a clear film material 14 having a *translucent* coating on its rear side instead of the translucent cling vinyl film 16 of Charley et al since Boden teaches that instead of translucent plastic, a transparent plastic having a translucent coating on its rear side can be used for making daylight visual displays.

Obviously, the same daylight visual effect would be achieved in Charley et al in view of Boden if clear film material 14 were having a *translucent* coating on its front side.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a clear film material 14 having a *translucent* coating on its front side instead of the translucent cling vinyl film 16 of Charley et al in view of Boden since obviously, the same daylight visual effect would be achieved if clear film material 14 were having a *translucent* coating on its front side.

18. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al in view of Boden, further in view of Taylor et al and Rega et al.

Charley et al in view of Boden are applied here for the same reasons as above. Charley et al in view of Boden fail to teach that” (i) the translucent cling vinyl film 16 has thickness in the range of 4-10 mils; (ii) UV-curable varnish contains UV inhibitor.

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As to (i), Taylor et al teach that polyvinyl chloride film about 50-150 microns thick (2-6 mils) commonly known as cling vinyl or static cling vinyl are flexible and can be used for carrying an image thereon to produce self-adhering stickers for automobile windows (self-adhering window covering), decals, etc. (See column 4, lines 27-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a translucent cling vinyl film 16 having thickness in the range of 2-6 mils in a film 14 of Charley et al in view of Boden with the expectation of providing the desired self-adhering printed window covering since Taylor et al teach that cling vinyl or static cling vinyl having thickness of 2-6 mils can be used for carrying an image thereon to produce stickers for automobile windows (self-adhering window covering), decals, etc.

As to (ii), Rega et al teach that UV absorber added to UV curable systems including UV inks provides weathering protection (See column 14, lines 47-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added UV absorber to UV ink of Charley et al in view of Taylor et al with the expectation of providing the colored cling decal with desired UV absorbing properties for weathering protection, as taught by Rega et al.

19. Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al in view of Boden, further in view of Taylor et al and Rega et al, and further in view of Oberwager (US 3,815,263).

Charley et al in view of Boden, further in view of Taylor et al and Rega et al are applied here for the same reasons as above. Charley et al in view of in view of Boden, further in view of

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Taylor et al and Rega et al fail to teach that the window covering simulates a stained glass window.

Oberwager teaches that cling window covering can be made to simulate a stained glass window using assembled tiles of translucent plastic of different colors.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made a window covering of Charley et al in view of Boden, further in view of Taylor et al and Rega et al from assembled plastic tiles, each of which is printed with translucent inks of different colors and opaque lead lines with the expectation of providing the desired simulated stained glass window, as taught by Oberwager.

Response to Arguments

20. Applicant's arguments with respect to claims 4-5, 22-26, 36, 40-41, 51, and 54-61 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER
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December 1, 2005